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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,806	06/26/2001	Yong Jin Chang	858-11 CIP	2661
23869	7590	10/31/2005	EXAMINER	
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			COMSTOCK, DAVID C	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

88

Office Action Summary	Application No. 09/891,806	Applicant(s) CHANG ET AL	
	Examiner David Comstock	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 12-20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 8-10 and 12-20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamberg (1,942,332; of record).

Hamberg discloses an artificial fingernail comprising a nail body 11 that can be made from a transparent material (see col. 1, lines 17-24). The body has a nail bed portion and a nail tip portion and is adapted to be adhered to a natural fingernail (see Fig. 1 and col. 2, lines 29-33). The nail may have a tip portion provided with a covering of any desired color, which includes white (see col. 2, lines 19-28 and 37-38). The remaining portion of the nail can be uncolored (cf. col. 1, lines 18-22). The dividing line from bed to tip is aligned with the natural transition therebetween (see, e.g., Fig. 2). The nail bed portion is attached to the natural nail by cement and the tip portion projects beyond the end of the finger (see col. 1, lines 3-9). Hamberg does not explicitly disclose that the colored portion is paint. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the colored portion of paint, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Likewise, even though

Art Unit: 3733

Hamberg does not explicitly disclose the use of clear cement, it would have been obvious use such a material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. It would have been further obvious to provide the device with any desired decoration or color, since the resulting nail would amount to nothing more than one of numerous configurations a person of ordinary skill in the art would find obvious. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 8, 10 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamberg (1,942,332; of record) in view of Mast et al. (4,751,935; of record).

Hamberg discloses the claimed invention except for the nail base (as opposed to the nail bed). Mast et al. discloses that artificial nails comprising nail beds (corresponding to the natural nail bed) and nail tip portions and those comprising nail bases (corresponding the the distal end of a fingernail) and nail tip portions are functionally equivalent structures, known in the art, for decorating fingernails (see Figs. 1, 4, and 5 and col. 6, lines 47-57; also see Nakata et al. [4,615,348; previously cited] at col. 1, lines 29-34 and Wood [5,704,375; cited by applicant]). Therefore, since these two nail decorations were functionally equivalent structures known in the art at the time of the invention, it would have been obvious to a person of ordinary skill to substitute artificial nails comprising nail bases and nail tip portions for artificial nails comprising nail beds and nail tip portions, as such is merely the substitution of functionally equivalent nail decorations. It also would have been obvious to apply a transparent sealer, also in view of Mast, in order to protect the nail and make it last longer (see Mast et al. col. 1, lines 21-23 and col. 5, lines 22-24).

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamberg (1,942,332; of record) in view of Mast et al. (4,751,935; of record), as applied to claim 8 above, and further in view of Agee, II et al. (D380,867; of record).

The device of the combination of Hamberg and Mast et al. discloses the claimed invention except for the dividing line at an angle. Agee, II et al. disclose a similar device having a dividing line at an angle relative to the natural dividing line to provide a decorative appearance and enhance the ornamental appearance of the nails (see Fig. 1, Title, and Claim). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail and tip of the combination of Hamberg and Mast et al. with a dividing line oriented at an angle relative to the natural dividing line, in view of Agee, II et al., in order to provide a decorative appearance and enhance the ornamental appearance of the nails.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamberg (1,942,332; of record) in view of Bartolucci (3,982,551; of record).

Hamburg as modified discloses the claimed invention except for the kit. Bartolucci discloses a kit 10 comprising artificial fingernails 14 and adhesive 50 (see Fig. 1). The kit makes the nails easier to use and provides the nails and necessary supplies in an aesthetically attractive, compact, complete, and ready-to-use manner (see col. 1, lines 1-22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nails of Hamberg in a kit, in view of Bartolucci, in order to make the nails easier to use and to provide the nails and necessary supplies in an aesthetically attractive, compact, complete, and ready-to-use manner.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamberg (1,942,332; of record) in view of Bartolucci (3,982,551; of record), as applied to claim 15 above, and further in view of Ferrigno (4,450,848; of record).

The device of the combination of Hamberg and Bartolucci discloses the claimed invention except for the transparent acrylic filler. Ferrigno discloses an artificial fingernail forming method comprising applying a transparent filler having an acrylic powder along with a liquid cyanoacrylate adhesive rearward of the tip, allowing the combination to harden and to be buffed. This allows the artificial nail to remain on the natural fingernail longer and increases the potential market for the device (see col. 1, lines 15-29 and 42-53 and col. 2, Examples). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the artificial nail applying method of Hamberg and Bartolucci with a step of applying an acrylic filler composed of powder and liquid cyanoacrylate, in view of Ferrigno, in order to allow the artificial nail to remain on the natural fingernail longer and increase the potential market for the device.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamberg (1,942,332; of record) in view of Chang (5,782,248; of record).

Hamburg as modified discloses the claimed invention except for the transparent filler. Chang discloses that an additional layer of clear polish, i.e. a transparent filler, can be applied to increase the strength and durability of the nails and improve their cosmetic appearance (see Abstract and col. 3, lines 35-39). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the nail of Hamberg with a transparent filler, in view of Chang, in order to increase the strength and durability of the nails and improve their cosmetic appearance.

Response to Arguments

Applicant's arguments filed 22 August 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that applicant's device is intended to be used as a nail "tip," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the prior art of Hamberg clearly is at least capable of being adhered to a tip of a nail (see, e.g., Fig. 1).

In response to Applicant's argument that the bed of the nail is not transparent, it is noted that all the disclosures of a prior art reference must be considered in order to determine what the reference fairly teaches and suggests to a person of ordinary skill in the art. Applicant relies on a single embodiment exemplified in the Figures and on a particular portion of the disclosure that states that the "body portion of the shield 11 is provided with colored portion 15" (see, col. 1, lines 19-20). However, there are other passages in the disclosure that indicate that the device can be transparent and any portion can be colored or uncolored. For example, see column 1, lines 17-22, where the disclosure indicates that the device "can be constructed of either transparent or non-transparent material having a portion thereof suitably colored or uncolored..." (emphasis mine, as below). *Thus, as disclosed, any portion of the device can be transparent and any portion can be colored or uncolored.* In addition, see column 1, lines 11-12, which states that the device "may be suitably colored to suit the tastes of

Art Unit: 3733

the user..." (col. 1, lines 11-12). Note that whether the device is even colored at all is subject to no less than three qualifications in this preceding sentence alone! First, it says that the device "may be... colored." It does not say that it must be colored. Thus, as disclosed, it necessarily can be uncolored. Next, it uses the term "suitably colored," which implies subjectiveness and variability according to the needs or wishes of a user. Of course, the gamut of potential suitable choices is limitless. It may span from clear or white to, bright and garish colors, to black. Again, this determination is wholly subjective, and *clearly* not beyond the disclosure or the grasp of a person of ordinary skill in the art. Third, it says the device may be "colored... to suit the tastes of the user." Is it necessary or possible for the utility patent to enumerate and illustrate every *design* and *color* permutation?

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection and/or arguments presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3733


extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. Comstock
21 October 2005



EDUARDO C. ROBERT
PRIMARY EXAMINER